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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,294	10/06/2000	Masaaki Usui	107531	8349
25944	7590	08/26/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/679,294		USUI, MASA AKI	
	Examiner		Art Unit	
	Stefano Karmis		3624	WW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>06/03/2004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed on 05 May 2004.

Status of Claims

2. Claims 1-4 are amended. Claim 5 is previously presented. Claim 6 and 7 are left as originally filed. Therefore claims 1-7 are under prosecution in this application.

Summary of this Office Action

3. Applicant's arguments, filed 05 May 2004, with respect to the rejection(s) of claim(s) 1-7 under Schutzer et al. U.S. Patent 5,920,848 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Motoyama, U.S. Patent 5,913,202.

Response to Arguments

4. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Motoyama U.S. Patent 5,913,202.

Regarding independent claim 1, Motoyama discloses a method for the unified management of a plurality of assets allowing collective perusal of the real-time status of transactions and assets held by a user at a plurality of different companies by using a computer network, comprising the steps of: a client computer notifying a financial institution server to send asset information to a unified asset management server, said client computer making a request to said unified asset management server to update a portfolio; said unified asset management server making a request to said financial institution server to perform authentication; said financial institution server providing authentication when said unified asset management server is the server specified in the notification from said client computer; said unified asset management server making a request to said financial institution server to send said asset information, said financial institution server sending said asset information to said unified

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asset management server; said unified asset management server updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to said client computer (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49).

Regarding independent claim 2, Motoyama discloses a method for the unified management of a plurality of assets allowing collective perusal of the real-time status of transactions and assets held by a user at a plurality of different companies by using a computer network, comprising the steps of a financial institution server being notified to the effect that an event comprising a deposit/withdrawal process has taken place; said financial institution server notifying a unified asset management server to the effect that asset information will be sent, said financial institution server sending said asset information to said unified asset management server; said unified asset management server updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to a client computer (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49 and column 8, lines 49-62).

Claim 5, the unified management of a plurality of assets using a computer network for the step of sending said updated portfolio to an adviser server in order to receive advice (column 14, line 60 thru column 15, line 67).

Regarding independent claim 6, a unified asset management system comprising a plurality of assets databases corresponding to a plurality of financial institutions, a plurality of authentication information databases corresponding to said plurality of financial institutions, a portfolio database for storing portfolio information related to total assets in said plurality of financial institutions; a unified asset management server for receiving asset information from said plurality of financial institutions and storing same respectively in said plurality of asset databases, and, in addition, for preparing said portfolio based on said plurality of asset databases and storing same in said portfolio database; an authentication database for performing user authentication, an asset management database for managing a user's assets, a transaction management database for storing transaction information related to a user's assets, an event notification unit, which, when a transaction occurs, notifies said unified asset management server to that effect; and a financial institution server which is connected to said authentication database, said asset management database, and said transaction management database wherein said financial institution server sends asset information to said unified asset management server after the notification from said event notification unit (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49 and column 8, lines 49-62).

Regarding independent claim 7, Motoyama discloses a unified asset management system comprising: a plurality of assets databases corresponding to a plurality of financial institutions; a plurality of authentication information databases corresponding to said plurality of financial

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institutions, a portfolio database for storing portfolio information related to total assets in said plurality of financial institutions; a clock/calendar apparatus, a unified asset management server for receiving asset information from said plurality of financial institutions and storing same respectively in said plurality of asset databases, and, in addition, for preparing said portfolio based on said plurality of asset databases and storing same in said portfolio database; an authentication database for performing user authentication; an asset management database for managing a user's assets, a transaction management database for storing transaction information related to a user's assets, and a financial institution server connected to said authentication database, said asset management database, and said transaction management database, wherein said unified asset management server receives a signal from said clock/calendar apparatus, and makes a request to said financial institution server to send asset information, and said financial institution server receives a signal from said second clock/calendar apparatus and based on this signal makes a determination as to whether or not the request from said unified asset management server was made within a predetermined period of time, and, in addition, sends said asset information on the basis of the results of this determination (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49 and column 8, lines 49-62).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al. (hereinafter Motoyama).

Regarding independent claim 3, Motoyama teaches a method for the unified management of a plurality of assets allowing collective perusal of the real-time status of transactions and assets held by a user at a plurality of different companies by using a computer network and a unified management server, comprising the steps of a client computer making a request to a financial institution server to perform authentication, said financial institution server providing

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authentication, said client computer making a request to said financial institution server to execute a prescribed transaction; said financial institution server notifying said client computer of the results of the execution of said transaction; said client computer making a request to said unified asset management server to update a portfolio; said unified asset management server making a request to said financial institution server to perform authentication, said financial institution server providing authentication; said unified asset management server making a request to said financial institution server to send said asset information, said financial institution server sending said asset information to said unified asset management server; said unified asset management server updating a portfolio based on said asset information received and said unified asset management server sending an updated portfolio to said client computer (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49 and column 8, lines 49-62).

Motoyama fails to teach that the verification/authentication is made within a prescribed time from the execution of the transaction. Official Notice is taken that performing verification/authentication in a prescribed time limit is old and well known in the financial arts. Therefore it would have been obvious to someone of ordinary skill in the art that the teachings of Motoyama could be modified to specify verification/authentication in a prescribed time limit because it provides an efficient system for validating information before a transaction is completed to ensure correct procedures.

Regarding independent claim 4, Motoyama teaches a method for the unified management of a plurality of assets allowing collective perusal of the real-time status of transactions and assets held by a user at a plurality of different companies by using a computer network and a unified management server, comprising the steps of a unified asset management server being started up automatically by a timer; said unified asset management server making a request to said financial institution server to perform authentication, said financial institution server providing authentication; said unified asset management server making a request to said financial institution server to send said asset information; said financial institution server sending said asset information to said unified asset management server; said unified asset management server updating a portfolio based on the received said asset information; and said unified asset management server sending an updated portfolio to said client computer (column 4, lines 23-58 and column 6, line 48 thru column 7, line 49 and column 8, lines 49-62).

Motoyama fails to teach that the verification/authentication is made within a prescribed time from the execution of the transaction. Official Notice is taken that performing verification/authentication in a prescribed time limit is old and well known in the financial arts. Therefore it would have been obvious to someone of ordinary skill in the art that the teachings of Motoyama could be modified to specify verification/authentication in a prescribed time limit because it provides an efficient system for validating information before a transaction is completed to ensure correct procedures.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
19 August 2004


HANI M. KAZIMI
PRIMARY EXAMINER